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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,305	12/19/2000	Yves Le Gendre	Q62357	3328

7590

01/08/2004

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EXAMINER

GARY, ERIKA A

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 01/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,305

Applicant(s)

LE GENDRE ET AL.

Examiner

Erika A. Gary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 31, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over by DeFazio et al., US Patent Number 5,940,484 (hereinafter DeFazio) in view of Grube et al., US Patent Number 5,557,605 (hereinafter Grube).

Regarding claims 1 and 7, DeFazio discloses a method (and apparatus) of obtaining information regarding an identity of a caller in a terminal of a telephone communications network, the method comprising: the terminal receiving an incoming call from a caller and a telephone number of the caller; an agent of the terminal selecting at least an external server likely to be able to provide the information regarding the identity of the caller; the agent preparing a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller; and the agent sending the request to the sever [fig. 3a].

What DeFazio does not specifically disclose is that the agent resides in the terminal and includes a program or an application that is stored and activated on the terminal. However, Grube teaches this limitation.

Grube discloses providing caller data wherein the terminal comprises an agent to request caller data from an external server [col. 2: lines 5-15].

DeFazio and Grube are combinable because they are from the same field of endeavor, that is, providing caller data to a called party. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify DeFazio to include Grube. The motivation for this combination, as suggested by Grube, would have been to allow the terminal to request the caller data as it is not always needed or desired [col. 1: lines 31-39]. Further, it is known in the art to relocate one component's functionality to another component.

Regarding claims 2 and 8, DeFazio discloses the agent receiving a response to the request from the server; or if a response is not received at the agent, or if the response is not satisfactory, the agent selecting another server likely to be able to provide said information on the identity of the caller, preparing at the agent another request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, and sending from the agent the other request to the other server [col. 7: lines 17-23].

Regarding claims 3 and 9, DeFazio discloses receiving the response or selecting another server, preparing another request, and sending the other request to the other server are repeated if the response to the other request is not received at the agent or if the response to the other request is not satisfactory [col. 7: lines 17-23].

Regarding claims 4 and 10, DeFazio discloses the step of selecting at the agent at least one external server likely to be able to provide said information on the identity of the caller is performed by searching a request file [col. 7: lines 17-23].

Regarding claims 5 and 11, DeFazio discloses the terminal has a data channel and wherein the request is sent on the data channel [col. 8: lines 6-7].

Regarding claims 6 and 12, Grube discloses that the terminal is a mobile terminal [col. 2: lines 3-5].

Regarding claim 13, DeFazio discloses the terminal is a fixed terminal connected to the telephone network [fig. 2].

Regarding claim 14, DeFazio discloses the terminal is a fixed terminal having access to the Internet [col. 7: line 67 – col. 8: line 2].

Response to Arguments

3. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection. Newly cited reference to Grube teaches a terminal comprising an agent that requests caller data from an external server.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 703-308-0123. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh N. Tran can be reached on 703-305-4040. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750 or to the 2600 Customer Service Office at 703-306-0377.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive Arlington, VA., Sixth Floor (Receptionist).


Erika Gary
Primary Examiner

ERIKA GARY
PATENT EXAMINER

EAG
January 5, 2004